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PATENT

Application # 10/685,819

Attorney Docket # 2002P20757US (1009-027)

REMARKS

The Examiner is respectfully thanked for the consideration provided to this application. Reconsideration of this application is respectfully requested in light of the following remarks.

Claims 1-20 are now pending in this application. Each of claims 1, 5, 8, 11, 14, and 17 are in independent form.

I. Claim Construction

Before *prima facie* anticipation or obviousness criteria can be applied, the words of each claim must be interpreted. Federal Circuit, in *Phillips v. AWH Corp.*, 415 F.3d 1303, 75 USPQ2d 1321 (Fed. Cir. 2005) (*en banc*), *cert. denied*, 2006 U.S. LEXIS 1154 (U.S. Feb. 21, 2006) has clarified that:

1. "[t]he Patent and Trademark Office ('PTO') determines the scope of claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction '**in light of the specification as it would be interpreted by one of ordinary skill in the art**'" (*Id.* at 1316);
2. the words of a claim "are generally given their ordinary and customary meaning" (*Id.* at 1312);
3. the ordinary and customary meaning of a claim term is "the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention, i.e., as of the effective filing date of the patent application" (*Id.* at 1313);
4. "the person of ordinary skill in the art is deemed to read the claim term not only in the context of the particular claim in which the disputed term appears, but **in the context of the entire patent**, including the specification" (*Id.*);
5. even "the context in which a term is used in the asserted claim can be highly instructive" (*Id.* at 1314);
6. "the specification may reveal a special definition given to a claim term by the patentee that differs from the meaning it would otherwise possess. In such cases, the **inventor's lexicography governs**" (*Id.* at 1316);
7. even "when guidance is not provided in explicit definitional format, **the specification**

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may define claim terms by implication such that the meaning may be found in or ascertained by a reading of the patent documents” (*Id.* at 1321);

8. an “invention is construed not only in the light of the claims, but also with reference to the file wrapper or prosecution history in the Patent Office” (*Id.* at 1317 (*citing Graham v. John Deere Co.*, 383 U.S. 1, 33 (1966))); and
9. the “prosecution history... consists of the complete record of the proceedings before the PTO and includes the prior art cited during the examination of the patent” (*Id.* at 1317).

The present application implicitly defines the claim term “language” by stating, at paragraph 33, “the user can be prompted to select a language for rendering the information from a plurality of language choices ... Language choices can comprise any language, such as English, German, French, Italian, Spanish, and/or Chinese, etc.”

Accordingly, Applicant respectfully requests that the claim term “language” be interpreted as one skilled in the art would interpret that term in light of the implicit definition of the specification.

II. The Anticipation Rejections

Each of claims 11-13 was rejected as anticipated under 35 U.S.C. 102(b). In support of the rejection, various portions of U.S. Patent No. 5,659,705 (“McNutt”) were applied. These rejections are respectfully traversed.

A. The Legal Standards for Express Anticipation Rejections

To establish a *prima facie* case of express anticipation, the “invention must have been known to the art in the detail of the claim; that is, all of the elements and limitations of the claim must be shown in a single prior art reference, arranged as in the claim”. *Karsten Mfg. Corp. v. Cleveland Golf Co.*, 242 F.3d 1376, 1383, 58 USPQ2d 1286, 1291 (Fed. Cir. 2001); *See also* MPEP 2131. The single reference must describe the claimed subject matter “with sufficient clarity and detail to establish that the subject matter existed in the prior art and that its existence was recognized by persons of ordinary skill in the field of the invention”. *Crown Operations*

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Int'l, LTD v. Solutia Inc., 289 F.3d 1367, 1375, 62 USPQ2d 1917, 1921 (Fed. Cir. 2002).

Moreover, the prior art reference must be sufficient to enable one with ordinary skill in the art to practice the claimed invention. *In re Borst*, 345 F.2d 851, 855, 145 USPQ 554, 557 (CCPA 1965), *cert. denied*, 382 U.S. 973 (1966); *Amgen, Inc. v. Hoechst Marion Roussel, Inc.*, 314 F.3d 1313, 1354, 65 USPQ2d 1385, 1416 (Fed. Cir. 2003) ("A claimed invention cannot be anticipated by a prior art reference if the allegedly anticipatory disclosures cited as prior art are not enabled.")

The USPTO "has the initial duty of supplying the factual basis for its rejection." *In re Warner*, 379 F.2d 1011, 154 USPQ 173, 178 (CCPA 1967).

B. Analysis – Claims 11-13

McNutt fails to establish a *prima facie* case of anticipation. Specifically, *inter alia*, claim 11, from which each of claims 12 and 13 depends states, yet McNutt fails to teach, "prompting a user, on a user interface device connected to the PLC, to select for storage in the memory cartridge at least one project file element comprising a user program, a recipe comprising a plurality of input values, each input value from the plurality of input values corresponding to a process variable, a structure of the recipe stored separately from the recipe, a structure of a data log file stored separately from the data log file, and documentation relating to the at least one project file element, the structure of the data log file describing a location in the data log file of each of a plurality of identifying stamps, each identifying stamp comprising at least one of a calendar date and a clock time; and receiving a user input corresponding to a selection of the at least one project file element for storage in the memory cartridge".

Instead, the applied portion of McNutt recites, at col. 10, lines 41-60:

[a] supercapacitor is utilized to maintain data in portions of the RAM where such user values as mentioned are stored. In order to copy a program into the memory cartridge 52, all that is required is that the memory cartridge 52 be installed as previously indicated. A programming device such as 60 must then be used to command the 80C32 processor to copy the contents of the internal memory of the PLC to the memory

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cartridge 52 and thereafter the memory cartridge may be removed or left in place as desired. Upon writing of user programs to the memory cartridge 52, the program is first sent from the resident serial EEPROM to the RAM where a check-sum is performed and thereafter the user program along with the check-sum values as previously indicated are then sent to the memory cartridge. When the base unit 22 receives a command to copy the program; to a memory cartridge 52, RAM data such as the user program; the first 128/512 bytes of the user data; the station address; retentive range definitions if present; freeze/copy status and output table values for RUN to STOP transition; password and restriction classes, and all forced operands and their values are also automatically copied.

Applicant respectfully asks where this applied portion of McNutt:

- a. teaches "prompting a user" for anything?
- b. teaches "prompting a user" for anything "on a user interface connected to the PLC"?
- c. teaches "prompting a user, on a user interface device connected to the PLC, to select for storage in the memory cartridge at least one project file element comprising a user program, a recipe comprising a plurality of input values, each input value from the plurality of input values corresponding to a process variable"?
- d. teaches "a structure of a data log file stored separately from the data log file"?
- e. teaches "documentation relating to the at least one project file element"?
- f. teaches "the structure of the data log file describing a location in the data log file of each of a plurality of identifying stamps"?
- g. teaches "each identifying stamp comprising at least one of a calendar date and a clock time"?
- h. teaches "receiving a user input corresponding to a selection of the at least one project file element for storage in the memory cartridge"?

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Applicant respectfully submits that at McNutt does not teach “prompting a user, on a user interface device connected to the PLC, to select for storage in the memory cartridge at least one project file element comprising a user program, a recipe comprising a plurality of input values, each input value from the plurality of input values corresponding to a process variable, a structure of the recipe stored separately from the recipe, a structure of a data log file stored separately from the data log file, and documentation relating to the at least one project file element, the structure of the data log file describing a location in the data log file of each of a plurality of identifying stamps, each identifying stamp comprising at least one of a calendar date and a clock time; and receiving a user input corresponding to a selection of the at least one project file element for storage in the memory cartridge.”

Accordingly, it is respectfully submitted that the rejection of claim 11 is unsupported by McNutt and should be withdrawn. Also, the rejection of claims 12 and 13, each ultimately depending from independent claim 11, is unsupported by McNutt and also should be withdrawn.

II. The Obviousness Rejections

Each of claims 1-10 and 14-20 was rejected under 35 U.S.C. 103(a) as being unpatentable over various combinations of U.S. Patent No. 5,485,590 (“Hyatt”), U.S. Patent No. 6,473,749 (“Smith”), U.S. Patent No. 5,659,705 (“McNutt”), and/or U.S. Patent No. 5,801,942 (“Nixon”). Each of these rejections is respectfully traversed.

A. Legal Standards**1. *Prima Facie* Criteria for an Obviousness Rejection**

“To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach... all the claim limitations.” *See* MPEP 2143.

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Moreover, the "Patent Office has the initial duty of supplying the factual basis for its rejection." *In re Warner*, 379 F.2d 1011, 154 USPQ 173, 178 (CCPA 1967), cert. denied, 389 U.S. 1057, reh'g denied, 390 U.S. 1000 (1968). "It may not... resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in its factual basis". *Id.*

It is legal error to utilize to "substitute[] supposed *per se* rules for the particularized inquiry required by section 103. It necessarily produces erroneous results." *See In re Ochiai*, 71 F.3d 1565, 1571, 37 USPQ2d 1127, 1132-33 (Fed. Cir. 1998); *In re Wright*, 343 F.2d 761, 769-770, 145 USPQ 182, 190 (CCPA 1965).

"Once the examiner... carries the burden of making out a *prima facie* case of unpatentability, 'the burden of coming forward with evidence or argument shifts to the applicant.'" *In re Alton*, 76 F.3d 1168, 37 USPQ2d 1578 (Fed. Cir. 1996) (*quoting In re Oetiker*, 977 F.2d at 1445, 24 USPQ2d at 1444).

2. All Words in a Claim Must Be Considered

"To establish *prima facie* obviousness..., '[a]ll words in a claim must be considered'" MPEP 2143.03, quoting *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970); see also *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974); *In re Wilder*, 429 F.2d 447, 166 USPQ 545, 548 (CCPA 1970); *In re Angstadt*, 537 F.2d 498, 190 USPQ 214, 217 (CCPA 1976); *In re Geerdes*, 491 F.2d 1260, 180 USPQ 789, 791 (CCPA 1974).

3. Motivation or Suggestion to Combine References

"The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness." MPEP 2142. The requirements for fulfilling this burden are explicit and straightforward.

"[T]he examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed" (emphasis added). *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1458 (Fed. Cir. 1998). To show these reasons, "[p]articular findings must be made". *In re Kotzab*, 217 F.3d 1365, 1371, 55

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USPQ2d 1313, 1317 (Fed. Cir. 2000). Such factual findings must be supported by “concrete evidence in the record”. *In re Zurko*, 258 F.3d 1379, 1385-86, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001).

Moreover, a showing of combinability must be “clear and particular”. *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 161 (Fed. Cir. 1999). That strong showing is needed because, “**obviousness requires proof** ‘that the skilled artisan . . . would select the elements from the cited prior art references for combination in the manner claimed’”. *In re Johnston*, 435 F.3d 1381 (Fed. Cir. 2006) (quotation omitted) (emphasis added).

Consequently, an Office Action must clearly and objectively prove that the applied references are “reasonably pertinent to the **particular** problem with which the invention was involved”. See *Ruiz v. A.B. Chance Co.*, 234 F.3d 654, 664, 57 USPQ2d 1161, 1166 (Fed. Cir. 2000); *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1535, 218 USPQ 871, 876 (Fed. Cir. 1983); and *Monarch Knitting Machinery Corp. v. Sulzer Morat GmbH*, 139 F.3d 877, 881-83, 886, 45 USPQ2d 1977, 1981-82, 1985 (Fed. Cir. 1998).

In addition, “[t]he patent examination process centers on prior art and the analysis thereof. When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness.” *In re Sang-Su Lee*, 277 F.3d 1338, 1342, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002). Thus, the Office Action must clearly and objectively prove some “suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to”:

“select the references”;

“select the teachings of [the] separate references”; and

“combine [those teachings] in the way that would produce the claimed” subject matter.

In re Johnston, 435 F.3d 1381 (Fed. Cir. 2006) (internal citations omitted). See also *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998) (discussing the “the test of whether it would have been obvious to select **specific** teachings and combine them as did the applicant”) (emphasis added); and *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143,

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227 USPQ 543, 551 (Fed. Cir. 1985) (“When prior art references require selective combination... to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself.”). “The absence of . . . a suggestion to combine is dispositive in an obviousness determination.” *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573, 1579, 42 USPQ2d 1378, 1383 (Fed. Cir. 1997).

Further, this obviousness standard applies regardless of whether the Office Action relies upon modifying or combining purported teachings.

Although couched in terms of combining teachings found in the prior art, the same inquiry must be carried out in the context of a purported obvious modification of the prior art. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the **desirability** of the modification . . . It is impermissible to use the claimed invention as an instruction manual or template to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.

In re Fritch, 972 F.2d 1260, 23 USPQ 2d 1780, 1783-1784 (Fed. Cir. 1992) (citing *In re Gorman*, 933 F.2d 982, 987, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991); *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed. Cir. 1985); and *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ 2d 1596, 1600 (Fed. Cir. 1988) (internal quotations omitted) (emphasis added)).

Therefore, the Office Action also must clearly and objectively prove that the “prior art suggested the **desirability**” of that modification or combination. See also *Akamai Techs. v. Cable & Wireless Internet Servs.*, 344 F.3d 1186, 68 USPQ 2d 1186 (Fed. Cir. 2003) (“[w]hen determining the patentability of a claimed invention which combines two known elements, the question is whether there is something in the prior art as a whole to suggest the **desirability**, and thus the obviousness, of making the combination.”) (emphasis added).

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If an Office Action fails to set forth sufficient facts to provide a *prima facie* basis for the rejections, any future rejection based on the applied reference will necessarily be factually based on an entirely different portion of that reference, and thus will be legally defined as a “new grounds of rejection.” Consequently, any Office Action containing such rejection can not properly be made final. See *In re Wiechert*, 152 USPQ 247, 251-52 (CCPA 1967) (defining “new ground of rejection” and requiring that “when a rejection is factually based on an entirely different portion of an existing reference the appellant should be afforded an opportunity to make a showing of unobviousness vis-a-vis such portion of the reference”), and *In re Warner*, 379 F.2d 1011, 154 USPQ 173, 178 (CCPA 1967) (the USPTO “has the initial duty of supplying the factual basis for its rejection”).

B. Analysis**1. Claim 1**

The present Office Action presents **legally insufficient evidence**, of a “suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to”:

1. “select the references”;
2. “select the teachings of [the] separate references”; and
3. “combine [those teachings] in the way that would produce the claimed” subject matter.

Regarding selected proffered combinations, the present Office Action states, at Page 5:

[t]herefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the file management method of Smith with the system of Hyatt because it would provide for the purpose of allowing the user to search and identify data structure without editing the data file (see Col. 1 lines 53-58).

Yet, the portion of Smith applied to support this statement merely states, at col. 1, lines 53-58:

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[i]n particular, a system, and method for managing file content are provided that allow content authors to store data structures from a file in a data repository or structured storage. Content users may then perform searches to identify individual sub-file data structures, and may withdraw individual sub-file data structures without editing the file.

Applicant respectfully asks, where this applied portion of Smith provides a “suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to”:

1. “select the references”?
2. “select the teachings of [the] separate references?
3. and “combine [those teachings] in the way that would produce the claimed” subject matter?

Applicant respectfully submits that no legally sufficient suggestion or motivation has been shown to combine the applied portions of Hyatt with the applied portions of Smith to arrive at the claimed subject matter. Thus, the present Office Action fails to establish sufficient evidence of *prima facie* obviousness. Accordingly, Applicant respectfully requests a withdrawal of the rejection of claim 1. Applicant also respectfully requests a withdrawal of each rejection of claims 2-4, each of which depends from claim 1.

2. Claim 2

Since claim 2 depends from claim 1, Applicant respectfully incorporates by reference each argument presented, *supra*, regarding claim 1.

Applicant further respectfully submits that the present Office Action fails to provide any evidence whatsoever, for the additional claimed subject matter of claim 2, of any “suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to”:

1. “select the references”;
2. “select the teachings of [the] separate references”; and

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3. "combine [those teachings] in the way that would produce the claimed" subject matter.

Applicant respectfully submits that no legally sufficient suggestion or motivation has been shown to combine the applied portions of Hyatt with the applied portions of Smith to arrive at the claimed subject matter. Thus, the present Office Action fails to establish sufficient evidence of *prima facie* obviousness. Accordingly, Applicant respectfully requests a withdrawal of the rejection of claim 2.

3. Claim 3

Since claim 3 depends from claim 1, Applicant respectfully incorporates by reference each argument presented, *supra*, regarding claim 1.

Applicant further respectfully submits that the present Office Action fails to provide any evidence whatsoever, for the additional claimed subject matter of claim 3, of any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

1. "select the references";
2. "select the teachings of [the] separate references"; and
3. "combine [those teachings] in the way that would produce the claimed" subject matter.

Applicant respectfully submits that no legally sufficient suggestion or motivation has been shown to combine the applied portions of Hyatt with the applied portions of Smith to arrive at the claimed subject matter. Thus, the present Office Action fails to establish sufficient evidence of *prima facie* obviousness. Accordingly, Applicant respectfully requests a withdrawal of the rejection of claim 3.

4. Claim 4

Since claim 4 depends from claim 1, Applicant respectfully incorporates by reference each argument presented, *supra*, regarding claim 1.

Inter alia, claim 4 states, yet the applied portions of Hyatt fail to teach, "a support

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document relating to at least one of the user program, the recipe, and the data log file, **wherein the support document comprises images.**"

The present Office Action alleges, at Page 7, that:

Hyatt teaches a support document relating to at least one of the user program, the recipe, and the data log file (see Col. 8 lines 19-26, wherein the support document comprises images. *It should be noted that the support document comprises images set forth in the claim is give very little patentable weight. In the absent of any new or unexpected results, support document of Hyatt is similar to the applicant's invention.*

This allegation of the present Office Action provides no legal authority or basis for giving selected portions of the claimed subject matter admittedly missing from the applied portions of the relied upon references "very little patentable weight". Applicant further respectfully submits that this allegation of the present Office Action is facially contrary to the requirement that "the prior art reference (or references when combined) must teach... all the claim limitations." *See* MPEP § 2143. Accordingly, Applicant respectfully submits that the present Office Action fails to establish a *prima facie* case of obviousness regarding claim 4.

Applicant further respectfully submits that the present Office Action fails to provide any evidence whatsoever, for the additional claimed subject matter of claim 4, of any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

1. "select the references";
2. "select the teachings of [the] separate references"; and
3. "combine [those teachings] in the way that would produce the claimed" subject matter.

Applicant respectfully submits that no legally sufficient suggestion or motivation has been shown to combine the applied portions of Hyatt with the applied portions of Smith to arrive at the claimed subject matter. Thus, the present Office Action fails to establish sufficient evidence of *prima facie* obviousness. Accordingly, Applicant respectfully requests a withdrawal of the rejection of claim 4.

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The present Office Action presents **legally insufficient evidence**, of a “suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to”:

1. “select the references”;
2. “select the teachings of [the] separate references”; and
3. “combine [those teachings] in the way that would produce the claimed” subject matter.

Regarding selected proffered combinations, the present Office Action states, at Page 6:

[t]herefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the file management method of Smith with the system of Hyatt because it would provide for the purpose of allowing the user to search and identify data structure without editing the data file (see Col. 1 lines 53-58).

Yet, the portion of Smith applied to support this statement has been provided, *supra*, regarding the traversal of the rejection of claim 1.

Applicant respectfully asks, where this applied portion of Smith provides a “suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to”:

1. “select the references”?
2. “select the teachings of [the] separate references?”
3. and “combine [those teachings] in the way that would produce the claimed” subject matter?

Applicant respectfully submits that no legally sufficient suggestion or motivation has been shown to combine the applied portions of Hyatt with the applied portions of Smith to arrive at the claimed subject matter. Thus, the present Office Action fails to establish sufficient evidence of *prima facie* obviousness. Accordingly, Applicant respectfully requests a withdrawal of the rejection of claim 5. Applicant also respectfully requests a withdrawal of each rejection of

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claims 6 and 7, each of which depends from claim 5.

6. Claim 6

Since claim 6 depends from claim 5, Applicant respectfully incorporates by reference each argument presented, *supra*, regarding claim 5.

Applicant further respectfully submits that the present Office Action fails to provide any evidence whatsoever, for the additional claimed subject matter of claim 6, of any “suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to”:

1. “select the references”;
2. “select the teachings of [the] separate references”; and
3. “combine [those teachings] in the way that would produce the claimed” subject matter.

Applicant respectfully submits that no legally sufficient suggestion or motivation has been shown to combine the applied portions of Hyatt with the applied portions of Smith to arrive at the claimed subject matter. Thus, the present Office Action fails to establish sufficient evidence of *prima facie* obviousness. Accordingly, Applicant respectfully requests a withdrawal of the rejection of claim 6.

7. Claim 7

Since claim 7 depends from claim 5, Applicant respectfully incorporates by reference each argument presented, *supra*, regarding claim 5.

Applicant further respectfully submits that the present Office Action fails to provide any evidence whatsoever, for the additional claimed subject matter of claim 7, of any “suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to”:

1. “select the references”;
2. “select the teachings of [the] separate references”; and

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3. "combine [those teachings] in the way that would produce the claimed" subject matter.

Applicant respectfully submits that no legally sufficient suggestion or motivation has been shown to combine the applied portions of Hyatt with the applied portions of Smith to arrive at the claimed subject matter. Thus, the present Office Action fails to establish sufficient evidence of *prima facie* obviousness. Accordingly, Applicant respectfully requests a withdrawal of the rejection of claim 7.

8. Claim 8

Inter alia, claim 8 states, yet the applied portions of the relied upon references fail to teach, "prompting a user to select a **language** to display". The proper interpretation of the claim phrase "language" has been provided, *supra*. As indicated, *supra*, the present Application implicitly defines the claim term "language" by stating, at paragraph 33, "the user can be prompted to select a language for rendering the information from a plurality of language choices ... Language choices can comprise any language, such as **English, German, French, Italian, Spanish, and/or Chinese, etc.**"

Instead of teaching the claimed subject matter according to that definition, the portion of Nixon applied by the present Office Action allegedly states, at col. 3, line 58 – col. 4, line 20:

[i]n accordance with the present invention, a process control system includes a user interface which supports multiple IEC-1131 standard control languages and user-selection from among the control languages. From a single application routine, a user selects a control language from among a plurality of control languages including, for example, **Function Blocks, Sequential Function Charts, Ladder Logic and Structured Text, to implement a control strategy.** In one embodiment of the present invention, a process control system for controlling a process according to a control strategy includes a computer system having a processor, an input interface and a display coupled to the process and a software system. The software system includes an interactive, user-directed process configuration program with a plurality of control language editors for

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selecting the control strategy using a control language selected from a plurality of control languages.

In accordance with another aspect of the present invention, a method for configuring a process control environment controlled by a computer system having a processor connected to a display device includes the step of providing a plurality of instructional sections. An instructional section sets forth information relating to configuring the process control environment. The method also includes the steps of selecting a control language editor for defining a process control environment configuration, displaying on the display device a sequence of configuration screen presentations relating to the instruction sections as directed in terms of the selected control language editor; and guiding a user through the configuration of the process control environment via the sequence of configuration screen presentations.

Applicant respectfully submits that one skilled in the art would not equate the "language" stated in claim 8 as implicitly defined in the specification with the "control language" allegedly disclosed by Nixon.

Thus, even if there were motivation or suggestion to modify or combine the applied portions of the references relied upon in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, as attempted to be modified and/or combined, still do not expressly or inherently teach every limitation of the independent claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reconsideration and withdrawal of these rejections is respectfully requested.

Further, the present Office Action presents **legally insufficient evidence**, of a "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

1. "select the references";

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2. "select the teachings of [the] separate references"; and
3. "combine [those teachings] in the way that would produce the claimed" subject matter.

Regarding selected proffered combinations, the present Office Action states, at Page 6:

[t]herefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the selection of control languages of Nixon with the system of McNutt because it would provide for the purpose of allowing a single user to tailor various aspects of a system using the most appropriate language for a particular system aspect (see Col. 4 lines 21-27).

Applicant respectfully asks, where this applied portion of Nixon provides a "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

1. "select the references"?
2. "select the teachings of [the] separate references?"
3. and "combine [those teachings] in the way that would produce the claimed" subject matter?

Applicant respectfully submits that no legally sufficient suggestion or motivation has been shown to combine the applied portions of Hyatt with the applied portions of Smith to arrive at the claimed subject matter. Thus, the present Office Action fails to establish sufficient evidence of *prima facie* obviousness. Accordingly, Applicant respectfully requests a withdrawal of the rejection of claim 8. Applicant also respectfully requests a withdrawal of each rejection of claims 9 and 10, each of which depends from claim 8.

9. Claim 9

Since claim 9 depends from claim 8, Applicant respectfully incorporates by reference each argument presented, *supra*, regarding claim 8.

Claim 9 states, yet the present Office Action fails to even allege that any applied portion of any relied upon reference teaches, "locating in the memory cartridge the information stored in the selected language."

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Thus, even if there were motivation or suggestion to modify or combine the applied portions of the references relied upon in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, as attempted to be modified and/or combined, still do not expressly or inherently teach every limitation of the independent claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reconsideration and withdrawal of these rejections is respectfully requested.

Applicant further respectfully submits that the present Office Action fails to provide any evidence whatsoever, for the additional claimed subject matter of claim 9, of any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

1. "select the references";
2. "select the teachings of [the] separate references"; and
3. "combine [those teachings] in the way that would produce the claimed" subject matter.

Applicant respectfully submits that no legally sufficient suggestion or motivation has been shown to combine the applied portions of Hyatt with the applied portions of Smith to arrive at the claimed subject matter. Thus, the present Office Action fails to establish sufficient evidence of *prima facie* obviousness. Accordingly, Applicant respectfully requests a withdrawal of the rejection of claim 9.

10. Claim 10

Since claim 10 depends from claim 8, Applicant respectfully incorporates by reference each argument presented, *supra*, regarding claim 8.

Claim 10 states, yet the present Office Action fails to even allege that any applied portion of any relied upon reference teaches, "locating in the memory cartridge the information in a default language."

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Thus, even if there were motivation or suggestion to modify or combine the applied portions of the references relied upon in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, as attempted to be modified and/or combined, still do not expressly or inherently teach every limitation of the independent claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reconsideration and withdrawal of these rejections is respectfully requested.

Applicant further respectfully submits that the present Office Action fails to provide any evidence whatsoever, for the additional claimed subject matter of claim 10, of any “suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to”:

1. “select the references”;
2. “select the teachings of [the] separate references”; and
3. “combine [those teachings] in the way that would produce the claimed” subject matter.

Applicant respectfully submits that no legally sufficient suggestion or motivation has been shown to combine the applied portions of Hyatt with the applied portions of Smith to arrive at the claimed subject matter. Thus, the present Office Action fails to establish sufficient evidence of *prima facie* obviousness. Accordingly, Applicant respectfully requests a withdrawal of the rejection of claim 10.

11. Claim 14

The present Office Action presents legally insufficient evidence, of a “suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to”:

1. “select the references”;
2. “select the teachings of [the] separate references”; and

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3. “combine [those teachings] in the way that would produce the claimed” subject matter.

Regarding selected proffered combinations, the present Office Action states, at Page 7:

[t]herefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the file management method of Smith with the system of Hyatt because it would provide for the purpose of allowing the user to search and identify data structure without editing the data file (see Col. 1 lines 53-58).

Yet, the portion of Smith applied to support this statement has been provided, *supra*, regarding the traversal of the rejection of claim 1.

Applicant respectfully asks, where this applied portion of Smith provides a “suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to”:

1. “select the references”?
2. “select the teachings of [the] separate references?
3. and “combine [those teachings] in the way that would produce the claimed” subject matter?

Applicant respectfully submits that no legally sufficient suggestion or motivation has been shown to combine the applied portions of Hyatt with the applied portions of Smith to arrive at the claimed subject matter. Thus, the present Office Action fails to establish sufficient evidence of *prima facie* obviousness. Accordingly, Applicant respectfully requests a withdrawal of the rejection of claim 14. Applicant also respectfully requests a withdrawal of each rejection of claims 15 and 16, each of which depends from claim 14.

12. Claim 15

Since claim 15 depends from claim 14, Applicant respectfully incorporates by reference each argument presented, *supra*, regarding claim 14.

Applicant further respectfully submits that the present Office Action fails to provide any evidence whatsoever, for the additional claimed subject matter of claim 15, of any “suggestion,

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motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to”:

1. “select the references”;
2. “select the teachings of [the] separate references”; and
3. “combine [those teachings] in the way that would produce the claimed” subject matter.

Applicant respectfully submits that no legally sufficient suggestion or motivation has been shown to combine the applied portions of Hyatt with the applied portions of Smith to arrive at the claimed subject matter. Thus, the present Office Action fails to establish sufficient evidence of *prima facie* obviousness. Accordingly, Applicant respectfully requests a withdrawal of the rejection of claim 15.

13. Claim 16

Since claim 16 depends from claim 14, Applicant respectfully incorporates by reference each argument presented, *supra*, regarding claim 14.

Applicant further respectfully submits that the present Office Action fails to provide any evidence whatsoever, for the additional claimed subject matter of claim 16, of any “suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to”:

1. “select the references”;
2. “select the teachings of [the] separate references”; and
3. “combine [those teachings] in the way that would produce the claimed” subject matter.

Applicant respectfully submits that no legally sufficient suggestion or motivation has been shown to combine the applied portions of Hyatt with the applied portions of Smith to arrive at the claimed subject matter. Thus, the present Office Action fails to establish sufficient evidence of *prima facie* obviousness. Accordingly, Applicant respectfully requests a withdrawal of the rejection of claim 16.

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Inter alia, claim 17 states, yet the applied portions of the relied upon references fail to teach, “prompting a user to select a **language** to display”. In addition, *inter alia*, claim 17 states, yet the applied portions of the relied upon references fail to teach:

- a. “prompting a user to select a **language** to display”;
- b. “receiving a user input corresponding to a selected **language**”; and
- c. “responsive to the user input, displaying in the selected **language**, on the user interface device, the information comprising a project file stored in the memory cartridge.”

The proper interpretation of the claim phrase “language” has been provided, *supra*. As indicated, *supra*, the present Application implicitly defines the claim term “language” by stating, at paragraph 33, “the user can be prompted to select a language for rendering the information from a plurality of language choices ... Language choices can comprise any language, such as **English, German, French, Italian, Spanish, and/or Chinese, etc.**” Instead of teaching the claimed subject matter according to that definition, the portion of Nixon applied by the present Office Action allegedly states, at col. 3, line 58 – col. 4, line 20:

[i]n accordance with the present invention, a process control system includes a user interface which supports multiple IEC-1131 standard control languages and user-selection from among the control languages. From a single application routine, a user selects a control language from among a plurality of control languages including, for example, Function Blocks, Sequential Function Charts, Ladder Logic and Structured Text, to implement a control strategy. In one embodiment of the present invention, a process control system for controlling a process according to a control strategy includes a computer system having a processor, an input interface and a display coupled to the process and a software system. The software system includes an interactive, user-directed process configuration program with a plurality of control language editors for selecting the control strategy using a control language selected from a plurality of control languages.

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In accordance with another aspect of the present invention, a method for configuring a process control environment controlled by a computer system having a processor connected to a display device includes the step of providing a plurality of instructional sections. An instructional section sets forth information relating to configuring the process control environment. The method also includes the steps of selecting a control language editor for defining a process control environment configuration, displaying on the display device a sequence of configuration screen presentations relating to the instruction sections as directed in terms of the selected control language editor; and guiding a user through the configuration of the process control environment via the sequence of configuration screen presentations.

Applicant respectfully submits that one skilled in the art would not equate the “language” stated in claim 17 as implicitly defined in the specification with the “control language” allegedly disclosed by Nixon.

Thus, even if there were motivation or suggestion to modify or combine the applied portions of the references relied upon in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, as attempted to be modified and/or combined, still do not expressly or inherently teach every limitation of the independent claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reconsideration and withdrawal of these rejections is respectfully requested.

Further, the present Office Action presents **legally insufficient evidence**, of a “suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to”:

1. “select the references”;
2. “select the teachings of [the] separate references”; and

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3. "combine [those teachings] in the way that would produce the claimed" subject matter.

Regarding selected proffered combinations, the present Office Action states, at Page 8:

[t]herefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the selection of control languages of Nixon with the system of McNutt because it would provide for the purpose of allowing a single user to tailor various aspects of a system using the most appropriate language for a particular system aspect (see Col. 4 lines 21-27).

Applicant respectfully asks, where this applied portion of Nixon provides a "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

1. "select the references"?
2. "select the teachings of [the] separate references?
3. and "combine [those teachings] in the way that would produce the claimed" subject matter?

Applicant respectfully submits that no legally sufficient suggestion or motivation has been shown to combine the applied portions of Hyatt with the applied portions of Smith to arrive at the claimed subject matter. Thus, the present Office Action fails to establish sufficient evidence of *prima facie* obviousness. Accordingly, Applicant respectfully requests a withdrawal of the rejection of claim 17. Applicant also respectfully requests a withdrawal of each rejection of claims 18-20, each of which depends from claim 17.

15. Claim 18

Since claim 18 depends from claim 17, Applicant respectfully incorporates by reference each argument presented, *supra*, regarding claim 17.

Claim 18 states, yet the present Office Action fails to even allege that any applied portion of any relied upon reference teaches, "locating in the memory cartridge the information stored in the selected language."

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Thus, even if there were motivation or suggestion to modify or combine the applied portions of the references relied upon in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, as attempted to be modified and/or combined, still do not expressly or inherently teach every limitation of the independent claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reconsideration and withdrawal of these rejections is respectfully requested.

Applicant further respectfully submits that the present Office Action fails to provide any evidence whatsoever, for the additional claimed subject matter of claim 18, of any “suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to”:

1. “select the references”;
2. “select the teachings of [the] separate references”; and
3. “combine [those teachings] in the way that would produce the claimed” subject matter.

Applicant respectfully submits that no legally sufficient suggestion or motivation has been shown to combine the applied portions of Hyatt with the applied portions of Smith to arrive at the claimed subject matter. Thus, the present Office Action fails to establish sufficient evidence of *prima facie* obviousness. Accordingly, Applicant respectfully requests a withdrawal of the rejection of claim 18.

16. Claim 19

Since claim 19 depends from claim 17, Applicant respectfully incorporates by reference each argument presented, *supra*, regarding claim 17.

Claim 19 states, yet the present Office Action fails to even allege that any applied portion of any relied upon reference teaches, “locating in the memory cartridge the information in a default language.”

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Thus, even if there were motivation or suggestion to modify or combine the applied portions of the references relied upon in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, as attempted to be modified and/or combined, still do not expressly or inherently teach every limitation of the independent claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reconsideration and withdrawal of these rejections is respectfully requested.

Applicant further respectfully submits that the present Office Action fails to provide any evidence whatsoever, for the additional claimed subject matter of claim 19, of any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

1. "select the references";
2. "select the teachings of [the] separate references"; and
3. "combine [those teachings] in the way that would produce the claimed" subject matter.

Applicant respectfully submits that no legally sufficient suggestion or motivation has been shown to combine the applied portions of Hyatt with the applied portions of Smith to arrive at the claimed subject matter. Thus, the present Office Action fails to establish sufficient evidence of *prima facie* obviousness. Accordingly, Applicant respectfully requests a withdrawal of the rejection of claim 19.

17. Claim 20

Since claim 20 depends from claim 17, Applicant respectfully incorporates by reference each argument presented, *supra*, regarding claim 17.

Claim 20 states, yet the present Office Action fails to even allege that any applied portion of any relied upon reference teaches, "locating in the memory cartridge the information in a default language; and translating the information to the selected language."

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Thus, even if there were motivation or suggestion to modify or combine the applied portions of the references relied upon in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, as attempted to be modified and/or combined, still do not expressly or inherently teach every limitation of the independent claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reconsideration and withdrawal of these rejections is respectfully requested.

Applicant further respectfully submits that the present Office Action fails to provide any evidence whatsoever, for the additional claimed subject matter of claim 20, of any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

1. "select the references";
2. "select the teachings of [the] separate references"; and
3. "combine [those teachings] in the way that would produce the claimed" subject matter.

Applicant respectfully submits that no legally sufficient suggestion or motivation has been shown to combine the applied portions of Hyatt with the applied portions of Smith to arrive at the claimed subject matter. Thus, the present Office Action fails to establish sufficient evidence of *prima facie* obviousness. Accordingly, Applicant respectfully requests a withdrawal of the rejection of claim 20.

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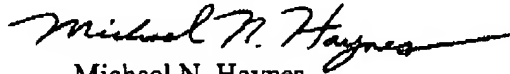
CONCLUSION

It is respectfully submitted that, in view of the foregoing amendments and remarks, the application as amended is in clear condition for allowance. Reconsideration, withdrawal of all grounds of rejection, and issuance of a Notice of Allowance are earnestly solicited.

The Office is hereby authorized to charge any additional fees or credit any overpayments under 37 C.F.R. 1.16 or 1.17 to Deposit Account No. 50-2504. The Examiner is invited to contact the undersigned at 434-972-9988 to discuss any matter regarding this application.

Respectfully submitted,

Michael Haynes PLC



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